

REMARKS

In the present communication, claims 28 and 42 have been amended; claims 41 and 53 have been canceled without prejudice or disclaimer; and no new claims have been added. The amendments are fully supported throughout the specification and claims as filed and do not add new matter.

Claim Objections

Claims 40 and 53 are objected to as allegedly being duplicative of one another. Without acquiescing to the rationale provided in the Office Action, and in order to expedite prosecution of the instant application, Applicants have canceled claim 53. Accordingly, Applicants respectfully request withdrawal of the objection.

Claims 41 and 42 are objected to as allegedly including informalities. Applicants have canceled claim 41 without prejudice or disclaimer rendering the objection moot as to such claim. With regard to claim 42, without acquiescing to the rationale provided in the Office Action, and in order to expedite prosecution of the instant application, Applicants have amended claim 42 to recite "the herpes virus" as requested. Accordingly, Applicants respectfully request withdrawal of the objection.

Claim 41 is objected to as allegedly being of improper dependent form. Applicants have canceled claim 41 without prejudice or disclaimer rendering the objection moot as to such claim. Accordingly, Applicants respectfully request withdrawal of the objection.

Rejection under 35 U.S.C. §103

Applicants respectfully traverse the rejection of claims 28, 31, 34-44, 49 and 53 under 35 U.S.C. §103(a) as allegedly unpatentable over Wallace et al. (U.S. Patent Application Publication 2003/00220294). Applicants note that claims 41 and 53 have been canceled rendering the rejection moot as to such claims.

Applicants note that Wallace et al. claims priority to U.S. Provisional Patent Application No. 60/366,429, filed on March 21, 2002. Accordingly, the earliest effective priority date for Wallace et al. is March 21, 2002. Applicants submit herewith a declaration under 37 C.F.R.

§1.131, by Dr. George Scheele, a co-inventor of the instant application and claims, along with Exhibits 1-4 thereto, which demonstrate that the claimed invention was reduced to practice in the United States prior to March 21, 2002, the earliest effective priority date of Wallace et al. Accordingly, Applicants submit that Wallace et al. is not available as prior art against the claimed invention.

With regard to submission of evidence in an amendment after final rejection, pursuant to MPEP §714.13, such evidence may be entered upon a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. Applicants respectfully submit that the evidence submitted herewith (Exhibits 1-4 to the declaration), is necessary to overcome the obviousness rejection based on Wallace et al. Such evidence was not submitted previously because Wallace et al. was never previously used to form the basis of a rejection in prosecution of the instant application. Accordingly, Applicants respectfully request entry and consideration of the declaration and Exhibits submitted herewith.

For the foregoing reasons, Applicants respectfully request the rejection be withdrawn.

Rejection under Nonstatutory Obviousness-type Double Patenting

Applicants respectfully traverse the provisional rejection based on nonstatutory obviousness-type double patenting of claims 28, 31, 34-44, 49 and 53 as allegedly obvious over claim 1 of copending U.S. Patent Application No. 11/605,037, in view of Wallace et al. (U.S. Patent Application Publication 2003/00220294). Applicants note that claims 41 and 53 have been canceled rendering the rejection moot as to such claims.

The recent U.S. Supreme Court decision in *KSR International v. Teleflex Inc.* (82 USPQ 2d 1385), modified the standard for establishing a *prima facie* case of obviousness. Under the *KSR* rule, three basic criteria are considered. First, some suggestion or motivation to modify a reference or to combine the teachings of multiple references still has to be shown. Second, the combination has to suggest a reasonable expectation of success. Third, the prior art reference or combination has to teach or suggest all of the recited claim limitations. Factors such as the general state of the art and common sense may be considered when determining the feasibility of modifying and/or combining references.

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness because the prior art references fail to teach or suggest all of the recited claim limitations. The Office Action concedes that U.S. Patent Application No. 11/605,037 does not require the measurement of viral load after beta-cyclodextrin is administered as claimed. To remedy such deficiency, the Office Action provides Wallace et al. stating that "as shown in Figure 1, Wallace et al. also measured herpes viral load after *in vitro* treatment of cells infected with herpes virus with beta-cyclodextrin to determine the effectiveness of beta-cyclodextrin against herpes virus" (see the Office Action page 10, line 21 through page 11, line 1). However, as discussed above, Wallace et al. is not available as prior art against the claimed invention. Applicants submit herewith a declaration under 37 C.F.R. §1.131, by Dr. George Scheele, a co-inventor of the instant application and claims, along with Exhibits 1-4 thereto, which demonstrate that the claimed invention was reduced to practice in the United States prior to March 21, 2002, the earliest effective priority date of Wallace et al. Accordingly, because Wallace et al. is not available as prior art against the claimed invention and U.S. Patent Application No. 11/605,037 fails to teach or suggest all of the recited claim limitations, the Office Action fails to establish a *prima facie* case of obviousness.

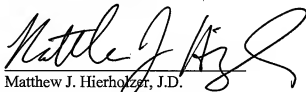
For the foregoing reasons, Applicants respectfully request the rejection be withdrawn.

Conclusion

In view of the amendments and above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

The Commissioner is hereby authorized to charge the total amount of \$65.00 for the One-Month Extension of Time, small entity, to Deposit Account No. 07-1896. No other fees are deemed necessary with the filing of this paper. However, the Commissioner is further authorized to charge any additional fees, or credit any overpayments, to Deposit Account No. 07-1896 referencing the above-identified docket number.

Respectfully submitted,



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